

**REMARKS**

Claims 4 and 5 were previously cancelled. With this amendment, claims 22-27 are also cancelled. It is believed that the cancellation of claims 22-27, along with the arguments presented below, places remaining claims 1-3 and 6-21 in condition for allowance.

***Claim Rejections – 35 USC § 103***

Claims 1-3, 6-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,299,295 to Kim et al. ("Kim") or U.S. Patent No. 5,475,403 to Havlovick et al. ("Havlovick") in view of Don Crabb, Intuit's Pocket Quicken Carries Benefits With It, Chicago Sun-Times, November 12, 1998, pg. 32 ("Crabb"). The applicants disagree.

With regard to claim 1, the preamble of the claim recites "[a] handheld electronic checkbook apparatus." Any terminology in the preamble that limits the structure of the claimed invention *must* be treated as a claim limitation. MPEP 2111.02, *citing* Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257 (Fed. Cir. 1989), emphasis added.

Thus, claim 1 is narrowly directed at a handheld electronic checkbook, and not at the larger general class of hand-held computing devices. The applicants explain that electronic checkbooks are intended to replace the typical paper-and-pen checkbooks that are carried by consumers (page 1, lines 6-7).

The Examiner alleges that "Pocket Quicken ... tracks and organizes multiple accounts including checks, cash, deposits, withdrawals, etc. on your Palm, i.e., acts as a checkbook." The applicants submit that the capabilities of the Pocket Quicken software package has no relevance or bearing with regard to claim 1. Claim 1 is a device claim that is directed at structural features of a handheld electronic checkbook. Nowhere does claim 1 recite features that are directed at financial tracking software, which is the subject of the Crabb reference.

At most, the Crabb reference suggests that financial software (Intuit's Pocket Quicken) may be installed on personal digital assistants, such as a Palm (Full text first paragraph). A PDA is not a handheld electronic checkbook, even though both may be broadly characterized as hand-held computing devices. As was explained by the applicants, electronic checkbooks are replacements for the typical pen and paper checkbooks carried by consumers (page 1, lines 6-7). PDAs such as the Palm cannot replace the typical pen and paper checkbooks carried by consumers because they cannot print checks as can a handheld electronic checkbook.

More to the point of claim 1, it has also been asserted that "Palm devices have a touch-sensitive display/input device and at least as of 1999 have a tiny virtual keyboard for tapping out letters using the stylus." This statement appears to be directed at the feature of claim 1 that recites "an input device configurable to receive financial data from a user through operation of a keyboard simulated and rendered on the input device."

While the applicants have no reason to believe that the Examiner's assertion regarding the Palm's touch-sensitive display/input device is untrue, the applicants note that it has yet to be pointed out where in the prior art there exists a motivation to incorporate the Palm's touch-sensitive display/input device into the handheld electronic checkbook as recited by the applicants in claim 1. Crabb certainly does not make such a suggestion, either explicitly or implicitly. Even when a combination of references teaches every element of the claimed invention, without a motivation to combine, a rejection based on *prima facie* obviousness is improper. MPEP 2143.01, *citing In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01, *citing In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). emphasis in original. Crabb does not suggest the desirability of incorporating the Palm's touch-sensitive display/input device into a handheld electronic checkbook as claimed by the applicants.

Finally, it has been asserted that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a Palm with the Quicken features." Again, there is no part of claim 1 that is directed at software capabilities such as managing or tracking transactions. Furthermore, statements indicating that modifications of the prior art to meet the claimed invention would have been, for example, "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. MPEP 2143.01, *citing Ex parte Levingood*, 28 USPC2d 1300 (Bd. Pat. App. & Inter. 1993).

For the above reasons, the Kim/Havlovick/Crabb reference fails to establish *prima facie* obviousness for claim 1, because none of the references contains a suggestion or motivation to incorporate an input device capable of simulating a keyboard as taught by the Palm PDA into a handheld electronic checkbook as taught by Kim or Havlovick. MPEP 2143.

The Kim/Havlovick/Crabb reference also fails to establish *prima facie* obviousness for claims 2 and 3 because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03, *citing In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

With regard to claim 6, similar to claim 1 it also recites a hand-held electronic checkbook apparatus that includes an input device configurable to receive financial data from a user through operation of a keyboard simulated and rendered on the input device.

Consequently, for the same reasons as explained above with respect to claim 1, the Kim/Havlovick/Crabb reference also fails to establish *prima facie* obviousness for claim 6.

The Kim/Havlovick/Crabb reference also fails to establish *prima facie* obviousness for claims 7-10 because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03, *citing In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

With regard to independent claims 11 and 16, they recite, *inter alia*, selecting a check format. It has not been alleged that Kim and/or Havlovick disclose this feature. Furthermore, Kim and/or Havlovick fail to disclose this feature, for the following reasons.

Kim teaches that the box-like base member 12 is configured to store a number of standard sized checks in a stacked arrangement (FIG. 1; column 3, lines 40-43). Thus, Kim's handheld electronic checkbook has no ability to select a check format because the checks that are stored in the base member 12 are pre-printed.

Havlovick teaches that checks are stored within check cavity 48 (FIG. 1; column 5, lines 47-48). Checks are advanced by roller shaft 44 (FIGs. 4a and 4b; column 7, line 61). Thus, Havlovick's electronic checkbook has no ability to select a check format because the checks that are stored within check cavity 48 are pre-printed.

Crabb does not disclose the feature of selecting a check format.

Consequently, the Kim/Havlovick/Crabb reference fails to establish *prima facie* obviousness for claims 11 and 16 because it does not teach or suggest all the features recited in the claim. MPEP 2143.03.

Claims 12-15 depend from claim 11 and claims 17-21 depend from claims 11 and 16, respectively. Consequently, the Kim/Havlovick/Crabb reference also fails to establish *prima facie* obviousness for claims 12-15 and 17-21 because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03, *citing In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Claims 22-27 are cancelled.

***Conclusion***

For the foregoing reasons, reconsideration and allowance of claims 1-3 and 6-21 is requested. Please telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

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I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office via facsimile number (703) 872-9306, on January 31, 2005.

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